

REMARKS

Initially, the Examiner identified two patentably distinct species of the claimed invention, identified as Group I, as set forth in FIGS. 1, 3 and 5, and Group II, as set forth in FIGS. 2, 9 and 10. Pursuant to 35 U.S.C. § 121, the Examiner has required Applicant to elect a single disclosed species for prosecution on the merits. In response, Applicant elected the species represented by Group I (FIGS. 1, 3 and 5 - claims 9-13 and 36-39) for prosecution on the merits, without traverse to said selection. In light of the apparent allowability of claim 31, the Examiner withdrew the requirement with regard to claims 36-39. As set forth below, the Applicant has amended claim 1 and believes the amendment has placed claim 1 in condition for allowance, thereby providing an allowable generic or linking claim for claims 1-22 (including claims 9-13).

The Examiner rejected claims 1-4, 8, 14, 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Price (U.S. Patent No. 5,836,490) in view of Pedrini (U.S. Patent No. 6,523,731). The Examiner objected to claims 6, 7 and 15-20 as being dependent upon a rejected base claim, but identified those claims as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Examiner identified claims 23-45 as being allowable. In response, the Applicant has amended claim 1 and has set forth arguments supporting the patentability of the claim. The Applicant believes the amendments made in response to the Examiner's rejections have placed the application in position for allowance.

Amendments to the Specification

The Applicant is amending the Specification at page 28, line 3 to correct an apparent typographical error with regard to the drawing referenced in the text. As set forth above, Applicant is changing the FIG. 14 reference to the correct FIG. 2.

Amendments to the Claims

Applicant has amended claim 1 to address the Examiner's rejection under 35 U.S.C. § 103(a). As set forth above, Applicant is amending claim 1 to clarify that the first and second support assemblies support the elongated body member transversely across the bed of the vehicle so as to support the motorcycle generally perpendicular to the elongated body member using one or more chock assemblies. This amendment is supported by the drawings and text, at least at FIGS. 1 and 2 and at page 8, line 12 through page 9, line 8; at page 18, line 14 through page 19, line 6; and at page 19, line 15 through page 20, line 2.

As set forth in more detail below, claim 1 is believed to be allowable in light of the prior art. As such, claims 2-22, which are all dependent from claim 1, are also believed to be allowable.

Rejection under 35 U.S.C. § 103(a)

With regard to the obviousness rejections for claims 1-4, 8, 14, 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Price in view of Pedrini, Section 103(a) only denies patentability to those inventions whose "subject matter as a whole would have been

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." (35 U.S.C. § 103.) Initially, as stated by the court in In re Geiger, 2 USPQ2d 1276 (CAFC 1987), "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." (In re Geiger, 2 USPQ2d at 1278.) The motivation or suggestion to combine references must exist, otherwise the determination of obviousness involves nothing more "than indiscriminately combining prior art." (Micro Chemical Inc. v. Great Plains Chemical Co., 41 USPQ2d 1238, 1244 (CAFC 1997).) In In re Fritch, 23 USPQ2d 1780 (CAFC 1992), the Federal Circuit stated the following:

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so. Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may

be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. ( In re Fritch, 23 USPQ2d at 1783-84 (internal quotes and citations removed).)

As to the amended claim 1, Applicant respectfully is of the opinion that nothing suggests combining the teachings of the referenced patents to arrive at Applicant's invention. Nothing in these references, or any knowledge generally available to one of ordinary skill in the art, compels, teaches, suggests or even offers any incentive such that an individual wanting to have a motorcycle rack with the attributes of Applicant's invention would utilize the teachings of the Price and Pedrini patents to achieve the advantages of Applicant's invention. (See In re Fritch, 23 USPQ2d at 1783; In re Geiger, 2 USPQ2d at 1278.)

With regard to Applicant's invention, claim 1 of the present patent, as amended, is directed to a motorcycle rack that supports a motorcycle in a generally upright position on a bed of a vehicle. The motorcycle rack has an elongated main body member that is supported at one end by a first support assembly and at the other end by a second support assembly in a manner that supports the main body member transversely across and above the bed of the vehicle so as to support the motorcycle generally perpendicular to the main body member. The wheel chock assemblies, which are connect to the main body member, hold a wheel of the motorcycle on or above the bed of the vehicle.

The Price patent discloses a bicycle rack having an elongated main body member that is attached to a side wall of the truck bed in a manner that the main body member is in the same direction of the truck bed, as opposed to transverse, and the bicycle is supported parallel to the main body member, as opposed to perpendicular thereto. Rotating the main body member to transverse to the truck bed would result in bicycle still being parallel to the main body member and would place it transverse to the truck bed. As set forth in Applicant's

Specification, one of the benefits of Applicant's invention is the ease of loading and unloading motorcycles from the bed of the vehicle. This benefit would appear to be lost or at least substantially reduced if the motorcycles had to be placed on the bed of the vehicle in a manner that resulted in the motorcycle being transverse to the truck bed. In addition, such a rotation would require the supports of Price to be attached to the sidewalls of the truck bed.

Pedrini discloses a carrier device for bicycles that has wheel chocks, previously cited by the Examiner in the obviousness analysis, that prevent movement of the bicycle during transport. Combining Price with Pedrini only provides the combined device with a chock assembly that, however, is still parallel to the direction of the main body member, resulting in the same problems set forth above. Absent hindsight, there is no reason to combine these two patents to achieve Applicant's invention, as set forth in the amended claim 1, that places the main body member transverse to the bed and the motorcycle generally perpendicular to the main body member. As such, the Applicant respectfully believes that claim 1 of the present patent application, as amended, is not obvious in light of Price, Pedrini or other prior art (see In re Fritch, 23 USPQ2d at 1783; In re Geiger, 2 USPQ2d at 1278) and should be found to be allowable.

In light of the above amendments and arguments, Applicant respectfully requests the Examiner to withdraw the rejection of claim 1, as amended, in the subject patent application.

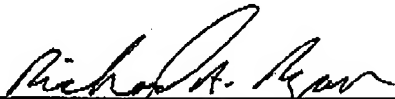
Applicant's original application included fees for three independent claims and a total of forty-five claims. No claims are being added and no claims are being deleted by this

Response/Amendment, therefore, no additional fees for claims are believed due. After this amendment a total of forty-five claims, including three independent claims, are pending in this application.

In view of the foregoing, it is submitted that this application is in condition for allowance. Reconsideration of the rejections in light of this Response/Amendment is requested. Applicant believes that the amended claims are in condition for allowance. Allowance of claims 1-45 is respectfully solicited.

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Respectfully Submitted,

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